

FEB 22 2007

PATENT

Attorney Docket No. UCSD-06783

REMARKS

Claims 37 and 70-75 have been considered in the instant Final Office Action. The Examiner has raised the following issues, which are set forth by number below in the order they are addressed herein:

- 1) Request to Correct Inventorship is allegedly deficient;
- 2) Specification is objected to under 35 U.S.C. § 132(a) as allegedly including new matter;
- 3) Claim 73 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement;
- 4) Claim 72 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite;
- 5) Claims 37 and 70-75 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,207,403 to Goldstein *et al.*, priority date of January 8, 1998 (Goldstein); and
- 6) Claims 37 and 70-75 stand rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Sakowicz *et al.*, *Science*, 280:292-295, April 10, 1998 (Sakowicz).

Applicants thank the Examiner for withdrawal of several of the rejections of the previous substantive Office Action. Nonetheless Applicants hereby amend Claim 72, and cancel Claim 73, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments. Applicants reserve the right to prosecute the original, similar, or broader claims in one or more future application(s). The amendments do not introduce new matter.

1-2) The Request to Correct Inventorship is Complete and the Specification Does Not Introduce New Matter

The Examiner alleges that the Request to Correct Inventorship dated August 15, 2005 is deficient for failing to include the written consent of the Assignee(s) of any of the originally named inventors. Applicants hereby submit a Statement of the Regents of the University of California (Tab A) and a Statement of the Board of Trustees of the Leland Stanford Junior

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University (Tab B), consenting to the request to add Lawrence S.B. Goldstein as a named inventor. Applicants contend that the Request to Correct Inventorship is now complete. Applicants further contend that the claim for the benefit of U.S. Application Nos. 09/724,609, 09/226,772 and 60/070,772 is proper, since Lawrence S.B. Goldstein is an inventor in common between the instant application and the prior applications. As such Applicants believe that the amendment to the priority claim is proper.

3) The Claims Meet the Written Description Requirement

The Examiner has rejected Claim 73 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner states

Applicant does not describe methods for assaying for therapeutic potential in animals or humans. Thus the invention of claim 73 reaches through to a product that has not been adequately described (Final Office Action, page 7).

Applicants respectfully disagree that the claims fail to comply with the written description requirement. Nonetheless, Applicants have canceled Claim 73, in order to further the prosecution of the present application and Applicant's business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). Applicants respectfully request that this rejection be withdrawn.

4) The Claims Are Definite

The Examiner has rejected Claim 72 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Examiner has rejected Claim 72 alleging that the term "screened simultaneously" is a relative term that renders the claim indefinite (Final Office Action, page 8). Applicants believe the claims as written are definite. Even so Applicants have amended Claim 72 by deletion of the term "simultaneously," in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). Accordingly, Applicants respectfully request that this rejection be withdrawn.

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The Examiner has rejected Claims 37 and 70-75 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,207,403 to Goldstein *et al.*, having a priority date of January 8, 1998 (Goldstein), and under 35 U.S.C. § 102(a) as allegedly anticipated by Sakowicz *et al.*, *Science*, 280:292-295, April 10, 1998 (Sakowicz). The Examiner maintained the anticipation rejections over Goldstein and Sakowicz stating that the instant application is not a continuation-in-part of Goldstein, because the correction of inventorship dated August 15, 2005 was not sufficient (Final Office Action, pages 8-12). Applicants contend that the Assignee Statements submitted herewith, complete the Request for Correction of Inventorship and as such the instant application is a proper continuation-in-part application. Thus, neither the Goldstein patent nor the Sakowicz publication pre-date the invention by Applicants and therefore do not anticipate the pending claims. Accordingly, Applicants respectfully request that these rejections be withdrawn.

Conclusion

Applicants believe the amendments and arguments set forth above traverse the Examiner's rejections and, therefore request that a timely Notice of Allowance be issued in this case. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect before the mailing of a further Office Action.

Dated: February 22, 2007

By: _____



Christine A. Lekutis
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TAB A

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1997.051-3M1

PATENT

Attorney Docket No. UCSD-06783

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Ronald Vale *et al.*

Serial No.: 10/031,819

Group No.: 1639

Filing / 371(c) Date: 08/12/2002

Examiner: Shibuya, M.L.

Entitled: **ASSAYS FOR DETECTING MODULATORS OF
CYTOSKELETAL FUNCTION**

STATEMENT OF ASSIGNEE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

1. The Regents of the University of California, 1111 Franklin Street, Oakland, California 94607, is an Assignee of U.S. Application No. 10/031,819, filed on August 12, 2002. This Assignment was recorded by the United States Patent and Trademark Office on August 12, 2005, on reel 016635, frame 0800.
2. The undersigned, as an officer of the Assignee, is authorized to act on behalf of the Assignee.
3. The undersigned hereby consents to the requested change in inventorship. In particular, the undersigned agrees that Lawrence S. B. Goldstein should be added to the list of named inventors. Lawrence S. B. Goldstein was erroneously and without deception omitted as a named inventor when the above-referenced application was filed.

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4. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: JANUARY 25, 2007By: Name: Jane MooresTitle: Interim DirectorUniversity of California Technology Transfer

The Regents of the University of California
1111 Franklin Street
Oakland, California 94607

TAB B**FEB 22 2007**

1997-051-3m.

PATENT

Attorney Docket No. UCSD-06783

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEIn re Application of: Ronald Vale *et al.*

Serial No.: 10/031,819

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Examiner: Shibuya, M.L.

Entitled:

**ASSAYS FOR DETECTING MODULATORS OF
CYTOSKELETAL FUNCTION****STATEMENT OF ASSIGNEE**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

1. The Board of Trustees of The Leland Stanford Junior University, 1705 El Camino Real, Palo Alto, California 94306, is an Assignee of U.S. Application No. 10/031,819, filed on August 12, 2002. This Assignment was recorded by the United States Patent and Trademark Office on September 15, 2005, on reel 016807, frame 0573.

2. The undersigned, as an officer of the Assignee, is authorized to act on behalf of the Assignee.

3. The undersigned hereby consents to the requested change in inventorship. In particular, the undersigned agrees that Lawrence S. B. Goldstein should be added to the list of named inventors. Lawrence S. B. Goldstein was erroneously and without deception omitted as a named inventor when the above-referenced application was filed.

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4. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 01/30/2007By: Katharine KuName: KATHARINE KUTitle: DIRECTOR

The Board of Trustees of
The Leland Stanford Junior University
1705 El Camino Real
Palo Alto, California 94306